

Application No.: 10/000284

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REMARKS

Claims 1-35 are currently pending and were previously presented. Claims 36-52 are cancelled.

Claim Rejections – 35 USC § 102 – Fukuda

Claims 36-42, 44-48, and 51 stand rejected under 35 USC 102(c) as being anticipated by Fukuda (US 6, 740, 152 B1). This rejection is considered moot given the cancellation of these claims.

Claim Rejections – 35 USC § 103

In the Interview Summary of November 28, 2005, the Examiner suggested submitting a declaration containing comparative data in order to establish the unexpected or surprising results over the cited prior art, and that such data would provide evidence of unexpected results obtained by the Applicant. Reference is made to the concurrently submitted declaration in which the Applicant describes unexpected results obtained with experimental ink formulations comprising the silyl-terminated sulfo(polyester-urethanes) of claim 1.

In the last response, Applicant provided extensive background information in an effort to explain how and why paper and ink jet ink compositions differ from each other. Applicant respectfully requests reconsideration of this information. In particular, Applicant emphasizes that to say that they are similar *ignores the methods by which each is applied to the paper, taking into account only the end result, i.e., the final product*. In summary, the background information described:

- some of the complex technical issues that the experimenter must face when designing formulations for ink or paper coatings;
- that small changes in the identities and the amounts of ingredients may have huge effects on rheological properties of the formulations as well as their performance after being applied on a substrate;
- some of the requirements of ink jet inks which make it difficult to jet particle-containing solutions; and

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- the complexity of coating technology, that one cannot readily assume that formulations useful in one coating process could be useful in another, yet alone be useful in an ink jet ink, and that designing a suitable formulation can take years to develop.

Claim Rejections – 35 USC § 103 – Sano et al. in view of Krepski et al.

Claims 1-2, 4, 6, 8-9, 15-27, 34-35 stand rejected under 35 USC § 103(a) as being unpatentable over Sano et al. (US 2003/0236321) in view of Krepski et al. (US 5,929,160).

The Examiner states that Krepski et al. discloses the silyl-terminated sulfopoly(ester-urethane)s of the present claimed invention, and that being drawn to paper, it would have been obvious to one of ordinary skill in the art to use these polymers in the inks of Sano et al., and thereby arrive at the claimed invention.

Applicant respectfully disagrees. With respect to the declaration submitted herewith, and to the background information summarized above and detailed in the last response, one of ordinary skill in the art of ink jet ink compositions would not, after reading Sano et al., consider the teachings of Krepski et al. and have a reasonable expectation that the particles disclosed therein would be suitable for use in ink jet ink compositions. Thus, Applicant submits that, for at least this reason, a *prima facie* case of obviousness has not been established and respectfully requests withdrawal of this rejection.

Claim Rejections – 35 USC § 103 – Zhu et al. in view of Krepski et al.

Claims 1-5, 9-16, 23-25, 27, 31, 41-50, and 52 stand rejected under 35 USC § 103(a) as being unpatentable over Zhu (US 5,889,083) in view of Krepski et al. (US 5,929,160). Given that claims 41-50 and 52 have been cancelled, the rejection with respect to these claims is considered moot.

The Examiner states that Krepski et al. discloses the silyl-terminated sulfopoly(ester-urethane)s of the present claimed invention, and that being drawn to

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paper, it would have been obvious to one of ordinary skill in the art to use these polymers in the inks of Zhu et al., and thereby arrive at the claimed invention.

Applicant respectfully disagrees. With respect to the declaration submitted herewith, and to the background information summarized above and detailed in the last response, one of ordinary skill in the art of ink jet ink compositions would not, after reading Zhu et al., consider the teachings of Krepski et al. and have a reasonable expectation that the particles disclosed therein would be suitable for use in ink jet ink compositions. Thus, Applicant submits that, for at least this reason, a *prima facie* case of obviousness has not been established and respectfully requests withdrawal of this rejection.

Claim Rejections – 35 USC § 103 – Erdtmann et al. in view of Krepski et al.

Claims 1-2, 4-9, 15-16, 23-25, 27-30, 32-37, 40, 42, 44-49, and 51-52 stand rejected under 35 USC § 103(a) as being unpatentable over Erdtmann et al. (US 6,533,408 B1) in view of Krepski et al. (US 5,929,160). Given that claims 36, 37, 40, 42, 44-49, and 51-52 have been cancelled, the rejection with respect to these claims is considered moot.

The Examiner states that Krepski et al. discloses the silyl-terminated sulfopoly(ester-urethane)s of the present claimed invention, and that being drawn to paper, it would have been obvious to one of ordinary skill in the art to use these polymers in the inks of Erdtmann et al., and thereby arrive at the claimed invention.

Applicant respectfully disagrees. With respect to the declaration submitted herewith, and to the background information summarized above and detailed in the last response, one of ordinary skill in the art of ink jet ink compositions would not, after reading Erdtmann et al., consider the teachings of Krepski et al. and have a reasonable expectation that the particles disclosed therein would be suitable for use in ink jet ink compositions. Thus, Applicant submits that, for at least this reason, a *prima facie* case of obviousness has not been established and respectfully requests withdrawal of this rejection.

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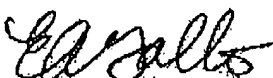
In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

02-06-06

Date

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